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| 66880 7590 03/24/2008<br>STEPTOE & JOHNSON, LLP<br>2121 AVENUE OF THE STARS<br>SUITE 2800<br>LOS ANGELES, CA 90067 |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/662,605  
Filing Date: September 15, 2003  
Appellant(s): ROEMER ET AL.

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Joel Landau  
For Appellant

**Substitute EXAMINER'S ANSWER**

This Substitute Examiner Answer results from APPEAL CENTER RETURN 3/11/08 to include a heading for section (2) and provide a Directors signature for the new grounds for rejection.

This is in response to the appeal brief filed 12/4/07 appealing from the Office action mailed 9/34/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

***Claim Rejections - 35 USC § 112***

**NEW GROUND(S) OF REJECTION**

Claims 33 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 33, "the prizes associated therewith" lacks a proper antecedent. Claim 46, depends from cancelled claim 30, as such its scope cannot be determined. While these types of errors are normally easily corrected by amendment, they are made of record here as they were previously overlooked in error.

***Claim Rejections - 35 USC § 102***

**NEW GROUND(S) OF REJECTION**

Claims 31, 32, 34, 45 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Monte Carlo.

Where previously these claims were rejected under 35 USC 103, upon reconsideration it was considered to more appropriately reject these under 102 where each of the limitations in the claims are considered shown.

***Claim Rejections - 35 USC § 103***

Claims 33, 35, 36, 37-44 46-59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monte Carlo in view of Kelly 5,882,258 and further in view of Same Game.

This grounds for rejection remains the same as in the final rejection with the exception of the claims that were removed from this grounds for rejection to be rejected under 102 as set forth above.

### **GROUND OF REJECTION WITHDRAWN**

The rejection of claims 31-61 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has not been sustained and is not presented before the Board for the purposes of this Appeal.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

5,882,258

Kelly

3-1999

Monte Carlo, "Hoyle's Modern Encyclopedia of Card Games", by Walter B. Gibson, (New York, Doubleday & Co.), 1974, pgs 343, 344.

Heins Palm Page, SAMEGAME,

<http://www.geoci~Jes.com/ResearchTriangle/System127711Pilot/palmpage.html>,  
3/1999.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### **DETAILED ACTION**

#### ***Claim Rejections - 35 USC § 112***

#### **GROUND(S) OF REJECTION WITHDRAWN**

The rejection of claims 31-61 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement since it does not disclose a "new random order" as called for in the claims, has not been sustained in view of appellant's remarks and further review of the specification at pg. 11, ln. 25- pg. 12, ln. 13. At this point in the specification, fig. 5 and 6 are discussed as two possible results of the "shuffling" and consolidating process claimed. In fig. 5, the pieces are "shuffled" such that a player can match and remove all the game pieces. In contrast, fig. 6 shows another possible arrangement that could have occurred rather than that of fig. 5 where a player cannot successfully remove all of the game pieces "due to their random placement ...after the consolidation of the second shuffle" (pg. 12, ln. 13). Here "random" implies any order may take place as shown in the differences between figs. 5 and 6.

#### **NEW GROUND(S) OF REJECTION**

Claims 33 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 33, "the prizes associated therewith" lacks a proper antecedent. Claim 46, depends from cancelled claim 30, as such its scope cannot be determined.

***Claim Rejections - 35 USC § 102***

**NEW GROUND(S) OF REJECTION**

Claims 31, 32, 34, 45 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Monte Carlo.

As to claims 31 and 32, Monte Carlo shows displaying a game grid of game pieces at the bottom of pg. 343, player input selecting adjacent game pieces that have matching indicia (pg. 344, Ins. 1 & 2), removing the game pieces (ln. 2) and shuffling remaining game pieces after all matching adjacent game pieces have been selected where "cards are then moved up to fill the spaces...more cards are then dealt in the usual order to restore the required total of twenty""(ln. 4-ln. 10) and finally repeating the selection removal process (ln. 10). This action in the play of Monte Carlo of moving up the cards to fill in the empty spaces from the matching cards that were removed is considered to be a "shuffling" process that causes "the remaining game pieces to be in a new random order". Here as the pieces are moved up and new cards are dealt to fill in, a player is presented with "a new grouping of the remaining pieces ion a new random order". Most broadly since the pieces are in a new location with respect to one another, this is considered to meet the recitation of "shuffling" to create a "new random order". Here the examiner has given "random" its ordinary meaning as : a haphazard course, at random: without definite aim, direction, rule or method. Appellant's own specification

does not lend any special meaning to the term. In fact at pg. 11, ln. 7 he states that his "shuffling process consolidates the remaining game pieces into a consolidated, contiguous arrangement that creates new adjacent pairs of game pieces". Using appellant's own definition of shuffling, the steps of Monte Carlo meet these limitations since moving up the cards to fill in "creates new adjacent pairs of game pieces". Claim 34 is shown at pg. 344, ln. 2. As to claim 41, the cards of Monte Carlo are considered "tiles". Claim 60 differs from claim 31 in that it uses the language "deactivating the matching adjacent game pieces", instead of removing. However, in Monte Carlo, the removing of the cards from the layout is considered to be "deactivating" the game pieces wherein they "cannot be selected again". As such, the language of the claim fails to distinguish over the applied art.

***Claim Rejections - 35 USC § 103***

Claims 33, 35, 36, 37-44 46-59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monte Carlo in view of Kelly 5,882,258 and further in view of Same Game.

As to claims 33 and 61, Monte Carlo is shown as a private game and does not award a prize. Kelly teaches that it would have been obvious to have awarded a player a prize in a private game like Monte Carlo (col. 1, Ins. 48-67) to play the game in a public place (col. 1, ln. 11) so that the game can be attractive to casinos. The type of indicia of claims 35 and 40-42 and prize as called for in claim 37-39 are considered to be an obvious rearrangement of printed matter and matter of choice. More particular to



claim 36, awarding a player a prize associated with the indicia corresponding to the game is considered old and well known. For example, in scratch off tickets a player will win a prize corresponding to the indicia revealed in the game. As to claims 43 and 44 touch screen technology is old as are video representations of known games. See Same Game playable on a computer or PDA. As to claim 46, buttons are shown at 60 of Kelly. As to claims 47-58, it is taught by Kelly that a player is rewarded in a game depending upon their tasks performed towards the games' objective. This is admittedly old by applicant on the top of pg. 2 of his specification. To have rewarded a player for selected tasks in the performance of a game like Monte Carlo would have been obvious as taught by Kelly to reward a player for successful play of the game. Applicant has not shown were the rewards are critical to the play of the game by solving any particular problem or producing any unexpected results. Currently the player receives a reward based upon a predetermined task that is deemed rewardable by the game designer. This is nothing new since player can be rewarded for an unlimited number of tasks during the play of a game. Interactive help features as called for by claim 59 is old to games.

#### **(10) Response to Argument**

The grounds for rejection under 112, 1st has not been sustained and appellant's remarks are considered moot.

**Claims 31-61 over Monte Carlo, Kelly and Same Game.**

Here in question before the Board is the breadth afforded to the term "random" used in the phrase in the claim "random order" in view of the prior art. As stated by appellant, in the game of Monte Carlo, pieces move up to fill in as cards are removed and more cards are dealt from the deck to restore the number of cards that were removed so that the total number of cards is twenty. See pg. 344, ln. 4 of Hoyles. As being recited in claim 31, the moving up of the pieces to fill in the applied art of Monte Carlo is considered "shuffling any remaining pieces" that presents "a new grouping of the remaining game pieces". This "shuffling" causes "the remaining game pieces to be in a new random order" most broadly since they are no longer in their same locations and now have a new order with respect to the other game pieces. The "remaining pieces being in a new random order" is clearly accomplished in Monte Carlo not only because of the moving of the pieces up to fill in the spaces of the removed pieces but also because the "new order" also includes new cards that have been randomly dealt. From the analysis above, it is clear that the claim fails to clearly distinguish over the applied art and this grounds for rejection should be affirmed.

Applicant believes that Monte Carlo's pieces are in the "same" order (pg. 6, ln. 20). Clearly this position is not well founded since appellant himself in the previous paragraph admits that the "cards are moved up to fill in" (ln. 16) which clearly amounts to a different order between the cards. Here appellant is asking the Board to read a narrow definition of the term random into the claims in order to distinguish over the art. However such is impermissible since the terms in the claims are to be afforded their

broadest reasonable interpretation. Here the selection, removal, moving up to fill and further dealing of cards to present the needed twenty cards total is clearly a random process since the player has no control over how the cards are going to become arranged with respect to one another.

As stated by the Board on numerous occasions, the name of the game is the claim. Here the language used when given its broadest reasonable interpretation fails to distinguish over the applied art and the Board is asked to affirm this grounds for rejection.

At the top of pg. 7 of the Brief, it is only by appellant's interpretation of Monte Carlo that it teaches "keeping the game pieces in a fixed order". However, the pieces in Monte Carlo move about in an unpredictable way depending upon which cards are removed when matched, moved upward in the "shuffle" to fill in and new cards being dealt. There is nothing "fixed" or predictable about how the remaining pieces in Monte Carlo find a new order. It is this unpredictable rearrangement of the cards in Monte Carlo that makes the game different each time it is played and meets the instant claim limitations as a "new random order" each time the cards are manipulated. In light of this, clearly, where appellant argues that Monte Carlo's teaching "to consolidate a plurality of game pieces" teaches away from causing a new random order has no merits and should not be persuasive to the Board.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be

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treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/William M Pierce/

Primary Examiner, Art Unit 3711

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/KAREN M. YOUNG/

Conferees: Director, Technology Center 3700

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714